

### Remarks

Applicants and their undersigned attorney have reviewed the Office Action of August 16, 20, 2007 in the above-identified patent application, together with the prior art references cited and relied on by the Examiner in the rejections of the claims. Applicant believes that the invention as previously presented is not anticipated by, and is not obvious in light of, the prior art. Applicant has amended the claims to expedite examination of the application. Reexamination and reconsideration of the application, and allowance of the claims is respectfully requested.

Applicant has considered the objections and rejections not based upon prior art, including various claim rejections under 35 U.S.C. §112, second paragraph, that were newly presented in the third Office Action. Applicant has corrected each issue identified by the Examiner. Applicant also identified additional language in the claims that might be problematic and has made appropriate corrections.

By interview, Applicant has previously demonstrated in-person how the subject clip is adapted to be bent. Applicant also demonstrated the flat/planar aspect of the installed subject clip and explained the benefits of the clip residing in a single plane. Applicant also discussed the need for the subject clip and historical context of the subject clip. Specifically, Applicant has explained the operation of the clip relative to the clips taught in U.S. Patent Nos. 4,455,791 and 6,735,907.

Claims 42, 55, 61-62, and 65 of the application are currently rejected under 35 U.S.C. § 102 as being anticipated by Elko et al (U.S. Pat. No. 4,455,791). In the amendment preceding the amendments presented above, Applicant did not broaden the scope of the claims. However, this is the first citation to Elko et al. as fully anticipating the subject application. It should be noted that the '791 patent is owned by the assignee of record in the subject application (Elko Products Company, Inc). Elko Products is highly familiar with the cited reference. In fact, Applicant has previously discussed the gutter clip disclosed in the '791 patent while discussing the previously cited 102 reference to Stevens (U.S. Pat. No. 6,735,907).

To reiterate, the clip in Stevens is attached via a fastener to a gutter (see, the '907 patent abstract). The fastener requires an anchor or "tang" in order for the fastener to secure the Stevens clip to a gutter. Because the clip exists in at least two planes (i.e., the tang is perpendicular to the main body of the Stevens clip), the clip is more difficult to store, handle, manufacture, ship, and install. As a result, installation times are increased, holes for the associated fastener are required in the customer's gutters, and the manufacturing and shipping costs for the clip are relatively high.

The Stevens clip was created as an attempt to improve upon the Elko clip in the '791 patent (Elko '791). The Stevens' patent states, "Because the clip used in the Elko system [of the '791 patent] is not securely attached to either the gutter or the cover, it can become dislodged during stormy or windy weather." There was no understanding that the Elko '791 patent could lock to

a gutter.

The subject application claims a gutter clip with a locking lever and a hinge. The locking lever is adapted to bent at the hinge to bring a jaw into a *locking position* against the gutter. As demonstrated, previously discussed, and highlighted by the Stevens patent, the Elko '791 patent does not teach, suggest, or inherently include this structural feature.

The subject application is the first recognition and development of a gutter clip with a locking lever bendable at a hinge. It required considerable time and effort to develop and prove that a clip might be adequately secured in place without a separate fastener. The development included research as to specific dimensional ratios. These ratios are thought to allow acceptable operation of the clip regardless of the size of the clip. The '791 patent has no recognition whatsoever that this concept was even desirable, much less doable.

The clip in the '791 patent illustrated in Figure 7, as cited by the Office Action, is "stamped out of sufficiently rigid metal or plastic, such as, for example, a sheet of rigid aluminum alloy." (See Column 6, lines 10-13). Absent a definition in the specification to the contrary, terms are given their ordinary meaning. In this case, 'rigid' is defined in Merriam-Webster's online dictionary as "1a: deficient in or devoid of flexibility **b**: appearing stiff and unyielding." The Cambridge International Dictionary of English defines 'rigid' as "stiff or fixed; not able to be bent, moved, changed or persuaded." The width of the '791 clip might be varied, but the specification dictates that the clip is rigid. Therefore, the '791 patent cannot be said to anticipate a gutter clip with

a "locking lever adapted to be bent" or a hinge of any kind.

Importantly, the Office Action does not indicate where in the '791 patent there is a teaching of a hinge or locking lever where the locking lever is adapted to be bent at said hinge to bring said third jaw into a locking position against said gutter. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The Examiner has not identified an explicit teaching in the '791 patent of the hinge or locking lever that can be bent at the hinge. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with the recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference." Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991)(emphasis added). Applicant has personal knowledge, confirmed by the Stevens reference and as supported by the attached Declaration, that the Elko '791 clip did not have a locking lever or hinge adapted to lock to the gutter. The reference teaches that the clip is rigid (i.e., unbendable). Applicant, therefore, respectfully requests evidence that such a feature appears in the alleged anticipatory reference.

As the '791 patent does not disclose each and every element of the independent claims, the '791 patent cannot anticipate the independent claims, or any claims depending therefrom, under 35 USC 102. Nevertheless, Applicant has amended independent claims 42 and 65 to further include the

element of a bending slot. A new claim 80 is also presented.

The present Office Action also rejects, under 35 U.S.C. 103(a), claims 43-45, 56, 63, 67 and 74-79 as being unpatentable over Elko in view of Doussot et al. (U.S. Patent No. 5,426,832). As noted above, applicant disagrees that Elko '791 teaches or suggests a locking lever joined to the body portion by a hinge wherein the locking lever is adapted to be bent at the hinge to bring a jaw into a locking position against a gutter. Elko '791 and Doussot also do not teach a bending slot with the claimed structure or dimensions.

In fact, Elko '791 teaches away from the subject clip. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." See MPEP 2141.02; W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). "It is improper to combine references where the references teach away from their combination." MPEP 2145; In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (fed. Cir. 1983). Clearly, the teaching that the Elko '791 clip is rigid would lead one of skill in the art away from concept of a bendable, lockable clip. The Elko '791 clip of Figure 7 is disclosed as being rigid (i.e., unbendable). In fact, Elko '791 teaches that even if the clip is relatively thin, the clip should still be rigid in order to operate properly. As such, Dousset cannot be properly combined with Elko '791 to teach the subject clip with a hinge and a locking lever adapted to be bent about the hinge.

The accepted wisdom, at the time of the invention, was that a gutter clip could not be adequately secured to gutter without a fastener. See, e.g., the

Stevens '907 patent. Proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. MPEP 2145. There is no teaching, suggestion, or permissible combination of references that would indicate the specific structure or operation of the subject invention was even considered or thought to be feasible prior to the disclosure of the subject application.

The clip of the subject application has experienced relative commercial success compared to the '791 clip, which is no longer even on sale. The Declaration from Mr. Staub of Elko Products is attached in support of this indicator of non-obviousness. The Declaration is directed to each of the pending claims, as amended.

In summary, based on the disclosure of Elko '791, Elko '791 cannot teach or suggest a locking lever or hinge where the locking lever is bent at the hinge. Therefore, there is no anticipation. The Elko clip is rigid and therefore teaches away from the operation and structure of the subject clip. Elko '791 does not lock to the gutter, as confirmed by the Stevens patent and the Declaration of Mr. Timothy G. Staub (see below). The subject clip has had established commercial success relative to the Elko '791 clip. The locking lever of the subject clip must be forcibly released to disassemble the system. For example, an installer could use a screwdriver to leverage the locking jaws closed via the bending slot. The clip does not "unlock" when the installer removes the screwdriver from the bending slot.

Applicant believes the rejections regarding a mere change in size are moot in light of the above remarks and attached evidence. In any event,

neither of the cited references teaches the dimensions or structure of the subject invention. The claimed product operates differently and has a different structure than the alleged combination. Therefore, it cannot be said that the only difference between the alleged combination and the subject claims is a recitation of relative dimensions of the claimed device (see MPEP 2144.04). The Office Action cites to In re Rose, but the fact pattern of Rose is not applicable to this application. Rose dealt with merely increasing the size of a lumber package. The subject application claims specific dimensional ratios that would allow for the proper operation of the claimed clip.

The specific ratios discussed in the dependent claims are also not a mere change in size because the ratios relate the dimensions of one aspect of the clip to another. Regardless of the size of the clip, only the subject inventor determined and disclosed the dimensional ratios that provide for the operation of the claimed clip. The cited references do not recognize that the concept of the subject application was desirable, much less doable.

The previously submitted Declaration of Timothy G. Staub was apparently not considered as it did not set forth what rejections the declaration was addressing or set forth the claims to which the declaration was directed.

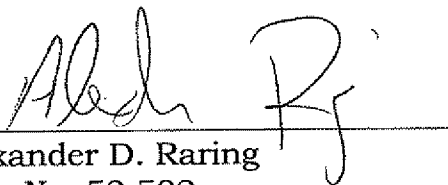
In further support of the non-obviousness of the present invention, Applicant is submitting herewith the Declaration of Timothy G. Staub, the President of Elko Products and Gutter Genius, LLC. The declaration is addressed to each pending claim, as amended. As is apparent from the Staub Declaration, the Elko '791 clip was a rigid, unbendable clip. The Elko '791 clip is no longer

commercially available due to lack of demand. The subject clip has enjoyed significant commercial success due specifically to the claimed structure of the gutter cover system and clip. In fact, the 'Gutter Genius' entity is working to create gutter protection franchises built around the claimed product.

For any one or more of the foregoing reasons, Applicant respectfully submits that the claims are in condition for allowance. Favorable action is requested hereon.

Payment for a one-month extension of time is filed herewith. Otherwise, it is believed that there are no fees associated with this filing. However, in the event the calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 50-2127.

Respectfully Submitted,

A handwritten signature in dark ink, appearing to read 'Alex Raring', is written over a horizontal line.

Alexander D. Raring  
Reg. No. 52,502

Date: December 3, 2007

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: David G. Filippi	)	
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Application No.: 10/798,779	)	Group Art Unit: 3637
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Filed: March 12, 2004	)	
	)	Examiner: Christine T. Cajilig
For: GUTTER COVER SYSTEM	)	
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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Declaration by Timothy Staub

Dear Sir:

I, Timothy G. Staub, declare and say:

1. I am President and CEO of Elko Products, the assignee of record in the above-identified case.. I am also President of Gutter Genius, LLC. I have studied the Office Action of August 16, 2007 in this case and the amended claims presented concurrently herewith. Similarly, I have restudied the present application. I submit this Declaration in support of the patentability and non-obviousness of all the pending claims as amended in the present application. My Declaration as follows applies to the Examiner's rejections based on 35 USC 103.

2. The claims as amended capture the commercial embodiment of the Elko "GuttaGard" gutter protection system and gutter clip. Specifically, the GuttaGard

system includes a solid sheet with one longitudinal edge formed into a curl. The cover extends downwardly and outwardly from the lowermost edge of a roof so that the curl extends downwardly toward a gutter. The GuttaGard clip is a flat body of a given thickness. Because the GuttaGard system eliminates fasteners found in other gutter protection clips, the entire clip exists within a single plane. The clip includes a first throat adapted to engage the cover's curl. An optional second throat engages the wall of a gutter (vertical or horizontal wall). Unlike the older Elko clip, as embodied in U.S. Patent No. 4,455,791, the GuttaGard clip provides a bendable locking lever. The lever has a hinge so that the first locking lever is adapted to be bent at the hinge to lock the second throat onto the gutter.

3. Even without fasteners, the GuttaGard clip provides an effective mechanism to positively secure the gutter cover in the proper position on the gutter. The clip also securely holds the gutter cover during high winds or inclement weather. The structure of the GuttaGard clip makes it easy to install and relatively inexpensive to produce.

4. Consumers of the GuttaGard system and clip include gutter installers and residential and commercial end users. End users have very specific demands regarding the price, appearance, and functionality of gutter cover systems. I have found the unique gutter cover system and clip of the present invention to be successful with gutter installers and end users. The success of the gutter cover system and gutter clip of the subject application is the direct result of our product, as currently claimed, to meet these end user demands. Specifically, the commercial success of the product is based, at least in part, on the planar clip structure and the ability to apply force to a bending slot in order to move a locking lever at a hinge. The claimed invention satisfies a long-felt

need and has succeeded in the market, particularly in comparison to the product claimed in the '791 Elko patent.

5. The gutter cover system and clip are most commonly sold via gutter installers who present various gutter protection options to the consumer. The system and clip provide advantages over the older Elko clip and other prior art systems during installation of the product. As noted, the product is easy to install, while being highly effective and reliable (less service calls for installers). The quick system installation allows the professional installer to visit more residences or commercial sites. This results in lowered labor costs and the ability to reach more customers. In addition, relatively little training or experience is required to install the gutter cover system. Gutter installers, therefore, suggest our product to end-users. Well over 50% of our gutter installer customers now sell our product exclusively. In other words, of the gutter installers that have experienced our product, a majority of the installers no longer sell any competing systems or products.

6. Gutter installers emphasize to consumers the low profile of our planar clip as well as the fact that the system is installed without fasteners passing through the consumer's gutter. The ability to bend the claimed clip provides a quick-connect clip not found in the Elko '791 patent or other prior art references. Residential consumers routinely select our product as the installers are enthused about our product, including the reliability it provides and the ease of installation.

7. Elko Products does not engage in advertising of any note. In 2006, Elko Products spent less than \$1000 for advertising the product. The success of our product is not due to significant advertising or "cut throat" pricing. The product, as

claimed in the patent application, is a superior product relative to the Elko '791 clip that gutter installers continue to learn about by word-of-mouth.

8. I have searched the accounting and financial documents of Elko Products and determined the following:

- From October 7, 2004 when Elko Products purchased the rights to the new clip through April 30, 2007 Elko Products generated overall revenue of \$1,248,351 in total sales.
- Over \$1,212,540 dollars of the revenue from October 7, 2004 through April 30, 2007 is directly attributable to sales of the claimed gutter cover system and gutter cover clip.
- Gross profits from GuttaGard were approximately \$620,670 from October 7, 2004 through April 30, 2007.
- Sales from GuttaGard system, as claimed by the subject invention, compare to sales of \$4,452 for the previous Elko clip (the '701 patent) that was obsolesced by the subject invention for the period October 7, 2004 through April 30, 2007.
- The Elko clip of the '791 patent is no longer sold for lack of commercial demand.
- Elko Products has sold more than 2 million feet of gutter cover system in accordance with the claims of the application in 2006. This is equivalent to about 14,285 households (assuming an average household gutter profile of 140 feet).

- Elko Products has built a national reputation for manufacturing and marketing the GuttaGard product with the Gutter Genius clip (the subject invention) as a high quality, easy-to-install alternative to the highly advertised gutter protection brands, and has secured a protected position as a direct result of the subject invention.

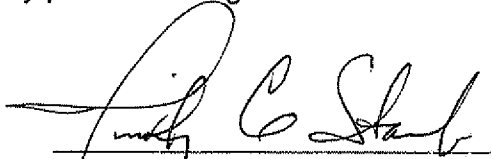
9. Gutter installation and gutter cover products are currently local or regional in nature. Therefore, it is impossible to calculate the market share of the claimed gutter cover system as a whole. Sales tend to grow by word-of-mouth. Sales are particularly strong in North Carolina, Virginia, South Carolina and Georgia. While it is impossible to accurately forecast demand and market share figures either nationally or regionally, we anticipate our market share in Raleigh, North Carolina in particular to be approximately 10%, and in Richmond, Virginia to be approximately 4-5%. We do anticipate continued growth in volume and market share as a direct consequence of the attributes of the subject invention. By invitation, Elko Products has demonstrated the product on the QVC network.

10. Largely due to the commercial success of the claimed gutter cover system and clip, the Gutter Genius, LLC entity was formed to create and pursue gutter protection franchises as a professionally installed system and as an independent seller of self installed gutter protection system (under the Gutter Genius DIY product nomenclature).

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements

and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 11/30/2007

  
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Timothy G. Staub